

## REMARKS

### STATUS OF THE CLAIMS

Claim 1-63 are pending in this application, and claims 1-63 stand rejected. No claim amendments are filed herein.

No new matter is being presented.

REJECTION OF CLAIMS 1-63 FOR OBVIOUSNESS UNDER 35 USC §103(a) AS BEING UNPATENTABLE OVER HSU ET AL. (U.S. PATENT NO. 6,377,956 B1) IN VIEW OF WORLD WIDE WEB CONSORTIUM, *XML SCHEMA PART I: STRUCTURES*, W3C WORKING DRAFT (MAY 6, 1999)

The rejections of claims 1-63 are respectfully traversed and reconsideration is requested.

#### I. Lack of *Prima Facie* Obviousness

It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness, as required by MPEP 2143, since there is no suggestion or motivation to modify Hsu et al. (hereinafter "Hsu").

##### A. *The Proposed Modification of Hsu Would Change the Principle of Operation*

It is respectfully submitted that the Examiner fails to respond to the assertion that the proposed modification of Hsu would change the principle of operation of the reference. MPEP 2143.01 states that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

The principle of operation in Hsu is to build product manuals "Based on the configuration specification of a product" (column 6, lines 39-42). Also, Hsu's principle of operation is to "assembl[e] product manuals based on a product model, a delivery model and a formal configuration specification" (Abstract, first sentence). To accomplish its purpose, Hsu provides a "Product Manual Configuration Specification Language (PMCSL), for the author to describe the logical structure of a product manual" (column 6, lines 31-37). Hsu has its own specific mode and principal for creating the structure of a document, namely, a user configuring the structure by hand to create a base of predetermined information that defines the document.

The rejection proposes modifying Hsu to structure a document based on or responsive to

documents in a file-system directory. However, this would alter Hsu's principle of operation, which is to structure a document based on the configuration specification of a product (see item 216 in Figure 2).

Therefore, the rejection is respectfully traversed because the proposed modification of Hsu would alter its basic mode of operation from a configuration-driven design to a directory-content driven design.

*B. The Fact that References Can be Combined or Modified is Not Sufficient to Establish Prima Facie Obviousness*

MPEP 2143.01 states, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

On page 3 of the Office Action, the Examiner suggests modifying Hsu to include "storing, each time one of the plurality of non-structured documents to be included in the hub document format structured document is prepared or edited, the non-structured document into the original document file-system directory", as recited in claim 1, for example.

There can be no motive to make a modification to solve a problem when that problem does not exist. Hsu does not need the modification proposed by the Examiner because Hsu has its own approach to the problem of updating or editing documents. In Hsu, "The product manual composition process keeps track of the configuration of a product manual at the document object level in the configuration specification file and the tables in the document database ... the present invention supports incremental processing such that a product manual may be incrementally updated" (column 15, line 65, to column 16, line 2). The proposed modification does not make sense because Hsu already has a mechanism allowing incremental updating/editing of documents.

Therefore, the prior art does not suggest the desirability of the modification. There exists no motivation to modify the references, and a *prima facie* case of obviousness has not been established. Hence, the rejection is respectfully traversed.

II. Hsu teaches Away from the Proposed Modification

It is respectfully submitted that the Examiner fails to consider that Hsu discloses "a system and method for assembling product manuals automatically based on product models"

(column 1, lines 12-14, emphasis added); the system of Hsu "automatically assembl[es] product manuals based on a product mode, a delivery model and a formal configuration specification" (column 2, lines 6-8). In other words, Hsu has its own specific means for building a hub document.

The Examiner acknowledges that "[Hsu does not teach] adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory." However, the Examiner proposes modifying Hsu to include this feature. In proposing this modification, the Examiner did not take into consideration the teachings of Hsu discussed above.

In making a *prima facie* case of obviousness, the Examiner is required to consider all teachings of the cited art, including those that teach away from the proposed modification. The Examiner has not taken into account teachings of Hsu that teach away from the proposed modification.

The Examiner has not disputed this characterization of the teaching of Hsu. Thus, it is respectfully submitted that the rejection is traversed.

### III. The Examiner Relies on Personal Knowledge in Taking Official Notice

The Examiner relies on personal knowledge in suggesting that Hsu can be modified to include "storing, each time one of the plurality of non-structured documents to be included in the hub document format structured document is prepared or edited, the non-structured document into the original document file-system directory," as recited in claim 1, for example.

"Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known. Assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art *must always* be supported by citation to some reference work recognized as standard in the pertinent art." In re Ahert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) (emphasis added).

Furthermore, as stated in MPEP 2144.03(C), "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence".

In the Response to Arguments on page 10 of the Office Action, the Examiner refers to Sato et al. (hereinafter "Sato") in supporting the rejection. The Examiner states, "Sato teaches converting a non-structured document into a structured document. Sato also teaches storing generated structured document[s] in the structured document repository," citing column 6, line 66 to column 7, line 35 and Fig. 18. However, the cited portions of Sato provide no discussion of storing, *each time one of the plurality of non-structured documents to be included in the hub document format structured document is prepared or edited*, the non-structured document into the original document file-system directory, as recited in claim 1, for example (emphasis added).

Therefore, the rejection must be withdrawn because the Examiner has relied on personal knowledge, and has not provided adequate evidence in support of the obviousness rejection.

#### IV. Rejection Fails to Address All of the Limitations of the Claims

According to MPEP 2143.03, "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (emphasis added). MPEP 2106 states that, "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation."

On page 4 of the Office Action, the Examiner concedes that Hsu does not disclose adding the entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory; however, he asserts that SML Schema Part I depicts a hub document based on the entity declarations regarding the structured documents, citing section 3.6.2. Moreover, the Examiner states, "one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used."

Claim 1 recites, in relevant part:

*automatically adding the entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations referring to the structured documents.* (emphasis added)

It is respectfully submitted that the Examiner has provided no references teaching

"automatically adding the entity declarations to the hub document ... by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations," as recited in claim 1, for example.

It is further submitted that *XML Schema Part 1* provides no guidance on how or when entity declarations can be added. Thus, it is respectfully submitted that the Examiner's unsupported assertions do not meet the recited feature of claim 1. The Examiner's personal knowledge teaching is only: "basing a hub document on entity declarations regarding the structured documents". However, this overlooks what claim 1 actually recites. Claim 1 recites when then entity declarations are obtained (responsive to presence of documents in a directory), and in connection how the entity declarations are obtained (acquiring document names of documents stored in a directory). The rejection addresses only the static structure and content of a hub document. The rejection does not address the particular mechanism for building a hub document that is recited in claim 1, for example.

Therefore, it is respectfully submitted that the rejection is traversed due to its clear deficiencies.

#### V. Claim 63 Remains Unexamined

The Examiner still has not directly addressed claim 63. Applicant notes that not all of the features of claim 63 have been examined. The rejection grouped claims 1, 49, 56, and 63 but only addressed the features of claim 1. As stated in MPEP 707.07(d), "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group."

The rejection of claim 1, however, cannot be equally applicable to claim 63 because claim 63 recites features not found in claim 1. Claim 63 recites "when preparing the hub document, automatically responding to the presence of the unstructured document files in the pre-determined directory by converting the unstructured document files to corresponding structured document files, where structure of the structured documents is given by markup tags included therein". The rejection does not address this feature and it is not taught or suggested by the prior art.

Claim 63 also recites "automatically acquiring a list of filenames of the respective structured document files in the pre-determined file-system directory, preparing corresponding

entity declarations, and adding same to the hub document". The rejection does not address this feature.

Claim 63 also recites that "but-for the presence of the structured documents in the pre-determined file-system directory they would not be referenced in the hub document and where the presence of the structured documents in the pre-determined file-system is what determines that they are to be referenced in the document directory". The Examiner has not addressed this feature, which is not found in claim 1.

Therefore, the current rejection of claim 1 is not equally applicable to claim 63. Thus, the rejection is further traversed for failure to establish a *prima facie* case of obviousness with respect to claim 63.

The above arguments are directed to claim 1, but are also applicable to independent claim 56.

#### CONCLUSION

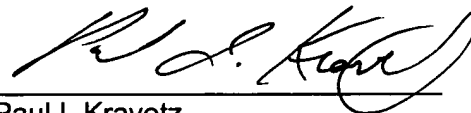
In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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